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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,155	07/21/2003	Jason S. Holland	9008-44	7693

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EXAMINER

PRUNNER, KATHLEEN J

ART UNIT PAPER NUMBER

3751

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/624,155

**Applicant(s)**

HOLLAND ET AL.

**Examiner**

Kathleen J. Prunner

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-13, 15-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Wuestman. Wuestman discloses a writing instrument (note Fig. 1) having all the claimed features including an elongated first barrel portion (constituted by barrel 10) that comprises an open first end (constituted by the lowermost end as shown in Fig. 1) through which a writing element is extended and an opposite open second end (note Fig. 3); a transparent, hollow second barrel portion (constituted by the transparent body section 11) that comprises an open third end (note the lowermost end as shown in Fig. 3) and an opposite fourth end (constituted by the uppermost end as shown in Fig. 3), wherein the third end is secured within the second end of the first barrel portion 10 (note Figs. 3 and 7), and wherein the third end has an annular rim, an internal surface and an external surface (note Figs. 3 and 4); a fluid (constituted by liquid 21) disposed within the hollow second barrel portion 11; and a plug 12 disposed within the third end, wherein the plug 12 prevents the fluid 21 from escaping from the hollow second barrel portion 11, wherein the plug 12 comprises a shank (constituted by coupling element 13) and a head portion (constituted by the enlarged end at 12 (note Fig. 3)) connected to the shank 13, wherein the head portion extends radially outward from the shank (note Fig. 3) to define a circumferential shoulder (note Fig. 3), wherein the shank 13 is disposed within the third end and the shoulder is in contacting relationship with the annular rim (note Fig. 3), and wherein the head portion tapers radially inward (note Fig. 3) such that the head portion does not contact an inside surface of the first barrel portion 10 second end (note Fig. 3) and such that any degree of flexure of the first 10 and second 11 barrel portions relative to one another does not cause the head portion to contact the inside surface of the first barrel portion 10 second end especially since the screw threads would prevent this type of contact. With respect to claim 4, Wuestman also discloses that the third end

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is threadingly secured within the second end (note Figs. 3 and 7 and lines 29-37 in the second column on page 1). With respect to claim 6, Wuestman further discloses that the fluid 21 is translucent (note lines 19-21 in the first column on page 2) and further includes at least one object (constituted by the solid or granular or discrete material 18) disposed within the hollow second barrel portion 11, wherein the object 18 is configured to move through the translucent fluid 21 when the writing instrument is inverted (i.e., in the normal writing position) relative to horizontal and wherein movement of the object 18 is viewable through the transparent second barrel portion 11 (note from line 52 in the second column on page 1 to line 5 in the first column on page 2, and from lines 41-60 in the first column on page 2).

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 3 and 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Tapner. Wuestman also discloses that the third end (i.e., the lower end of barrel portion 11 as shown in Fig. 3) is engaged to and secured in the upper end of the barrel portion 10 (note lines 29-34 in the second column on page 1) and that the parts of the writing instrument are formed of polymeric or plastic material (note lines 24-29 in the second column on page 1). Although Wuestman fails to disclose that the third end is adhesively secured, as called for by claim 3, or is welded, as called for by claim 5, attention is directed to Tapner who discloses another writing instrument having two barrel portions 10 and 11 which are either adhesively or cemented together or are welded together in order to provide a liquid-tight joint between the sections (note lines 11-23 in the second column on page 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to adhesively or cementingly secure or weld together the barrel portions of Wuestman in view of the teachings of Tapner in order to provide a liquid-tight joint between the sections so that there is no possibility of leakage.

5. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Lipic. With respect to claim 7, although Wuestman fails to disclose that the object 18 is configured to be buoyant within the fluid, attention is directed to Lipic who discloses an ornamental device that is mounted to another writing instrument 1 having a transparent, hollow second barrel portion (constituted by shell 2) that comprises an open third end and an opposite fourth end (note Fig. 4), a fluid (constituted by liquid 6) disposed within the hollow second barrel portion 2 and includes at least one object 5, 5a or 5b disposed within the hollow second barrel portion 2 wherein the object 5, 5a or 5b is configured to move through the translucent fluid 6 when the writing instrument is inverted (i.e., in the normal writing position) relative to horizontal and wherein movement of the object 5, 5a or 5b is viewable through the transparent second barrel portion 2 (note lines 4-7 in the first column on page 1) and the object 5, 5a or 5b is buoyant within the fluid 6 (note lines 48-49 in the second column on page 1) in order to form an ornamental writing instrument (note lines 1-3 in the first column on page 1) having a novel arrangement of elements that is not only decorative but also capable of varying its appearance whenever the position of the device is varied (note lines 4-7 in the first column on page 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to configure the object of Wuestman to be buoyant in the fluid in view of the teachings of Lipic in order to form an ornamental writing instrument having a novel arrangement of elements that is not only decorative but also capable of varying its appearance whenever the position of the device is varied. With respect to claim 8, Lipic additionally teaches the obviousness of providing the object with promotional indicia thereon (note Figs. 5-8, lines 12-19 in the first column on page 1 and lines 42-44 in the second column on page 1).

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Yeh. Although Wuestman fails to disclose that the fluid 21 contains a second fluid which is insoluble in the first fluid, attention is directed to Yeh who discloses another writing instrument having a transparent barrel body portion 2 containing a fluid constituted by one solvent 4 and a second solvent 41 which are insoluble in each other (note lines 10-13 in col. 1) in order to form

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various irregular patterns so as to achieve a visually entertaining effect (note lines 27-31 in col. 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to form the fluid 21 of Wuestman from two fluids that are insoluble in each other in view of the teachings of Yeh in order to form various irregular patterns so as to achieve a visually entertaining effect.

7. Claims 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker. Although Wuestman fails to disclose that the writing instrument includes a light configured to illuminate the fluid, attention is directed to Ducker who discloses another writing instrument having a light 30 configured to illuminate the image or indicia appearing on the upper portion of the barrel (note lines 36-38 in col. 1 and lines 21-25 in col. 2) in order to enhance its appearance for advertising purposes (note lines 5-17 in col. 1). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to provide the writing instrument of Wuestman with a light in view of the teachings of Ducker in order to illuminate the image or indicia appearing in the upper portion of the barrel and to enhance its appearance for advertising purposes. With respect to claim 12, Ducker further teaches the obviousness of using a power source constituted by battery 24 and a switch 30 in communication with the light 30 and power source 24 wherein the switch is responsive to user activation for switching the light on and off (note lines 30-60 in col. 4).

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang. Although Wuestman fails to disclose that the writing instrument includes a light configured to illuminate the fluid, attention is directed to Wang who discloses another writing instrument having a light 313 configured to illuminate the image or indicia appearing on the transparent surface of the barrel (note lines 7-11 and 49-51 in col. 1 and lines 35-36 in col. 2) in order to enhance its advertising purpose (note lines 64-67 in col. 2). It would have been obvious to one of ordinary skill in the writing instrument art, at the time the invention was made, to provide the writing instrument of Wuestman with a light in view of the teachings of Wang in order to illuminate the image or indicia and the transparent surface appearing in the transparent

portion of the barrel so as to enhance its advertising effect. With respect to claim 11, Wang also teaches the obviousness of disposing the light within the first barrel portion of the writing instrument (note Fig. 4). With regard to claim 12, Wang further teaches the obviousness of using a power source constituted by battery 315 and a switch 312 in communication with the light 313 and power source 315 wherein the switch is responsive to user activation for switching the light on and off (note lines 51-57 in col. 2).

9. Claims 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker for the same reasons noted above in paragraphs 2 and 7 supra.

10. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker as applied to claims 13 and 19 above, and further in view of Lipic for the same reasons noted above in paragraph 5 supra.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Ducker as applied to claims 13 and 19 above, and further in view of Yeh for the same reasons noted above in paragraph 6 supra.

12. Claims 13, 18-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang for the same reasons noted above in paragraphs 2 and 8 supra.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang as applied to claims 13, 18-20 and 23 above, and further in view of Tapner for the same reasons noted above in paragraph 4 supra.

14. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang as applied to claims 13, 18-20 and 23 above, and further in view of Lipic for the same reasons noted above in paragraph 5 supra.

15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuestman in view of Wang as applied to claims 13, 18-20 and 23 above, and further in view of Yeh for the same reasons noted above in paragraph 6 supra.

***Response to Arguments***

16. Applicant's arguments filed October 14, 2004 have been fully considered but they are not deemed persuasive.
17. In response to applicant's argument that the Wuestman reference discloses that the plug 12 is threadingly engaged with the barrel 10, it is considered that the claims do not preclude the use of such a threading engagement.
18. Applicant's argument with regard to the tapering of the plug in the Wuestman reference has been carefully considered. However, Fig. 3 of Wuestman clearly shows that the shank portion of the plug 12 does taper inwardly.

***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen J. Prunner whose telephone number is 571-272-4894. The examiner can normally be reached on Monday through Friday, 5:30 AM to 2 PM.
21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kathleen J. Prunner

December 9, 2004



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